



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,466	07/07/2003	Fumiyuki Isami	10209.512	7619

7590

07/01/2005

Kirton & McConkie  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, UT 84111

EXAMINER

SAYALA, CHHAYA D

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/614,466

Applicant(s)

ISAMI, FUMIYUKI

Examiner

C. SAYALA

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.  
4a) Of the above claim(s) 8-20 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 and 3-7 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 8-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The instant claims 8-20, Group II, are drawn to a method of making and using plant material, classified in class 47. The claims 1, 3-7, Group I, are drawn to product claims, classified in class 71. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of using the product can be practiced by using organic waste from food or animal waste, as known in the art. A reference that meets Group I claims will not meet the claims of Group II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search required for one Group is not required for the others, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-20 are withdrawn from consideration

Art Unit: 1761

as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification has been thoroughly reviewed but the claimed matter at claim 1, line 5, which is, that the *product of processed juice and pulp* was diluted could not be found. Page 4 states that an *extract* obtained from plant parts was diluted. Clarification is required. Upon applicant pointing out where the subject matter of the instant claims can be found, this rejection will be withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1761

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3 are rejected under 35 U.S.C. 102 (e) as being anticipated by West et al. (Publication No. 2003/0161 901 A1).

Paragraph (0037) at page 4 teaches a fruit juice and pulp mixed together with water (carrier) and having a moisture content of 0.1 to 80%. The preamble "fertilizer" is considered a "use term" and adds little to the prior art product. The discovery of a new property or use of a previously known composition, even when that property and use are unobvious from the prior art, cannot impart patentability to claims to the known composition. *In re Spada*, 15 USPQ 2d, 1655. See paragraph [0028] wherein the concentrate is diluted with water. Also, paragraph [0037] clearly indicates the addition of water.

2. Claims 1 and 3 are rejected under 35 U.S.C. 102 (b) as being anticipated by Wadsworth et al. (US Patent 6254913).

At col. 2, lines, patentees teach that "The juice and pulp are further processed". At col. 4, the patentees teach that "The juice and pulp can be dried" and "pasteurized". Such steps meet "processed Yaeyama Aoki juice" and "processed Yaeyama Aoki pulp". The juice and pulp are also combined with water and the product has a moisture content of 0.1 to 80%. See col. 4, lines 19-25. Thus this reference meets the amended

Art Unit: 1761

claimed product. The "fertilizer" terminology is however, a use terminology, and a new use for an old product does not render a product claim patentable.

3. Claims 1, 3 are rejected under 35 U.S.C. 102 (b) as being anticipated by Yegorova (US Patent 6403086).

Col. 8, lines 51-55 teaches a first extract of *Morinda citrifolia* fruit in water in a ratio of 1:4 (fruit:water). Extraction is inherently processing and fruit would include both juice and pulp. "The fertilizer" is use terminology and does not lend patentability to the claims. For composition claims, intended use of an otherwise old or obvious composition cannot render a claim patentable. *In re Zierden*, 162 USPQ 102, *In re Jones*, 50 USPQ 48, *In re Spada*, 15 USPQ 2d, 1655, *In re Thuau* 57 USPQ 324.

4. Claims 1, 3 are rejected under 35 U.S.C. 102 (b) as being anticipated by Hahn et al. (US Patent 6405948).

Claims 14, 15, 21, 30 of the reference, teach extracting plant matter, such as from Noni (*Morinda Citrifolia*) fruit, in water, col. 5, lines 55-60; col. 37. Example 2 teaches a 30% water extract of Noni fruit.

5. Claims 4-5, 7 are rejected under 35 U.S.C. 102 (b) as being anticipated by the publication from [www.nukahivtrading.com/noni.htm](http://www.nukahivtrading.com/noni.htm). (2/7/2002)

The literature shows that leaves are crushed for use, and roots and bark of the stem are used to obtain juice and dyes, which would inherently include processing.

Art Unit: 1761

6. Claim 6 is rejected under 35 U.S.C. 102 (b) as being anticipated by the publication from [www.incc.org/news\\_june.htm](http://www.incc.org/news_june.htm) (June 2002).

The seeds are roasted to be eaten. The claim has been met.

### ***Response to Arguments***

Applicant's arguments filed 3/31/05 have been fully considered but they are not persuasive.

Applicant's traversal of the 3 references West, Yegrova and Hahn cannot be agreed with. The patents all show the juice and pulp, processed and combined with water. The ratio applicant is claiming is 1: 2-10,000. This has been met by the references, and therefore, applicant's position is unclear. The rejections are being maintained.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references included show that historically natives from many old countries used noni for its various parts as dyes, for their medicinal value and even as fertilizers (see "W" reference on the form). This information is pertinent in view of the fact that the plant and its various parts and the various uses of such, were indigenous to the natives of these countries.

Art Unit: 1761

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



Application/Control Number: 10/614,466

Page 8

Art Unit: 1761

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "C. Sayala".

C. SAYALA  
Primary Examiner  
Group 1700.